

DOCKET NO.: WARF-0071 (P98067US)
Application No.: 09/257,585
Office Action Dated: 11/5/02 And 3/25/03

PATENT
REPLY FILED UNDER EXPEDITED
PROCEDURE PURSUANT TO
37 CFR § 1.116

REMARKS/ARGUMENTS

The Official Action dated November 5, 2002 and the Advisory Action dated March 25, 2003 have been carefully reviewed. In view of the amendments presented herewith and the following remarks, favorable reconsideration and allowance of this application are respectfully requested.

Status of the claims and prosecution:

Claims 1-7, 9, 11, 13, 14, 16, 25 and 26 were examined. In the November 5, 2002 Official Action, all pending claims were finally rejected.

The previous objection to claims 2, 3 and 11 because of informalities was withdrawn. The previous rejections of claims 11 and 13-16 under 35 U.S.C. §102(b) as anticipated by Sweigard et al. (1995) or Shimizu et al. (1991) were withdrawn.

Claims 1-7, 9, 11, 13, 14, 16, 25 and 26 remained rejected under 35 U.S.C. §112, first paragraph, for alleged lack of enablement.

Claims 1-7, 9, 25 and 26 remained rejected under 35 U.S.C. §112, first paragraph, for alleged lack of adequate written description. This rejection was previously applied to claims 11, 13, 14 and 16 in the Official Action mailed April 10, 2002, but was not so applied in the November 5, 2002 Action.

Claims 5, 6 and 13 were rejected under 35 U.S.C. §112, second paragraph, for alleged indefiniteness on the following grounds: (1) in claim 5, "having" should be replace with "of"; (2)

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in claims 6 and 13, alleged lack of clarity as to whether the cells or the vector comprises the nucleic acid molecule of claim 1 or 11, respectively.

All pending claims were deemed free of the prior art. The reason given was the failure of the prior art to teach or suggest an isolated nucleic acid of SEQ ID NO:1 or nucleic acids from *M. grisea* strain 2539 that hybridize to SEQ ID NO:1 under the conditions recited in claims 1 and 11, and cells transformed with those nucleic acids.

In Applicants' February 28, 2003 reply under 37 C.F.R. §1.116, Applicants requested entry of an amendment canceling claims 4 and 5 and amending claims 1, 6, 13, 25 and 26. Specifically, entry of amendments to claims 1 and 25 to specify that the nucleic acid molecules recited therein comprise an open reading frame that encodes a polypeptide comprising SEQ ID NO:4 was requested. Entry of amendments to claims 6 and to clarify that the vectors recited therein contain the nucleic acid molecule of claims 1 and 11, respectively, was requested. Entry of amendment to claim 26 to make the language more scientifically accurate was requested.

In the Advisory Action issued on March 25, 2003, the rejections of the pending claims were maintained on the ground that the claim amendments presented new issues and did not place the claims in condition for allowance. Further, the claim amendments were not entered for purposes of appeal. However, the examiner suggested that claim 1 be amended to claim an isolated nucleic acid molecule encoding SEQ ID NO:4 and that hybridization and source language be deleted. Presumably, with the cancellation and appropriate amendment of dependent claims, such claims would be allowable.

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Interview summaries:

The examiner agreed to review a proposed set of claim amendments, which were faxed to the examiner and discussed in a telephonic interview on August 27, 2003. Applicants thank the examiner for extending this courtesy. In the telephonic interview, further minor amendments to clarify the proposed amended claims were discussed, and it was agreed that those amendments would be made and submitted with a Second Reply under 37 C.F.R. §1.116. Accordingly, the agreed-upon claim amendments were submitted in a Second Reply under 37 C.F.R. §1.116 on August 29, 2003.

However, no further communication proceeded from the Patent Office, necessitating a further informal telephone interview with the examiner on November 10, 2003. In that interview, Applicants' undersigned attorney learned that a Notice of Non-Responsive reply had been issued, due to the fact that the scanned images of Applicants' August 29 reply were partially blank on each page, rendering them unreadable. Applicants' undersigned attorney believes that this error arose within the U.S. Patent and Trademark Office, inasmuch as photocopies of August 27, 2003 Reply (sent *via* U.S. Express Mail, not by facsimile) were complete and fully readable. Such copies can be provided to the examiner to support Applicants' statements, should they be required to advance prosecution of this application.

In view of the above, the examiner suggested that Applicants' re-submit the August 29 reply and any attachments thereto, *via* facsimile transmission of official papers. Accordingly, submitted herewith *via* official facsimile is a Supplement to Second Reply Pursuant to 37 CFR

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§1.116, with attached Exhibit I and accompanying Supplemental Information Disclosure Statement and cited references.

Claim amendments presented in this Reply:

In accordance with the present amendment, claims 2, 5, 11, 13, 14, 16 and 26 have been canceled. Claims 1, 3, 4, 6, 7, 9 and 25 remain pending. As the examiner suggested, claim 1 has been amended to call for an isolated nucleic acid molecule that encodes SEQ ID NO:4. Current cancellations, as well as the amendments to claims 3, 4, 6, 7 and 9, are made to accommodate the amendment to claim 1. Claim 25 has also been amended to now call for a transgenic epiphytic bacterium comprising a construct comprising an isolated nucleic acid molecule that encodes amino acid SEQ ID NO:4. Claim 26 is canceled as redundant in view of the amendment to claim 25.

Supplemental Information Disclosure Statement:

Submitted herewith is a Supplemental Information Disclosure Statement citing the International Search Report in PCT/US99/04047 (corresponding to the instant application) and one reference cited therein, Liew et al., *EMBL Accession No. N88845*, July 25, 1996. All other prior art references that the Applicants consider material to the claimed invention have already been submitted in the originally-filed Information Disclosure Statement and considered by the examiner.

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The Liew et al. reference was cited in the International Search Report of PCT/US99/04047 as relevant to the novelty of original claim 12, reproduced below for the examiner's convenience (along with original claim 11 from which it depended).

11. An isolated nucleic acid molecule having a sequence selected from the group consisting of:
- a) part or all of SEQ ID NO:1;
 - b) an allelic variant of part or all of SEQ ID NO:1;
 - c) a natural mutant of part or all of SEQ ID NO:1;
 - d) a sequence hybridizing with part or all of SEQ ID NO:1 or its complement and encoding a polypeptide substantially the same as any of the polypeptides encoded by SEQ ID NO:1; and
 - e) a sequence encoding part or all of a polypeptide having an amino acid sequence selected from the group consisting of SEQ ID NO:2, SEQ ID NO:3, SEQ ID NO:4, SEQ ID NO:5, SEQ ID NO:6, SEQ ID NO:7 and SEQ ID NO:8.

12. An oligonucleotide between about 10 and about 100 nucleotides in length, which specifically hybridizes with a portion of the nucleic acid molecule of claim 11.

The subject matter of claims 11 and 12 is no longer pending in this application.

However, for completeness, Applicants performed a pairwise BLAST(n) comparison (NCBI) between SEQ ID NO:1 (published as GenBank Accession No. AF463528) and the Liew et al. sequence. A copy of sequence AF463528 and the BLAST(n) search results are attached hereto as Exhibit 1. As can be seen, no significant homology was found between the sequences. Accordingly, Applicants respectfully submit that the relevance of Liew et al. to the originally claimed invention is questionable; however Liew et al. certainly is not material to the invention as currently claimed.

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Conclusion:

In view of the claim amendments submitted herewith and the foregoing remarks, the presently-pending claims are believed to be in condition for allowance. Applicants respectfully request early and favorable reconsideration and withdrawal of the objections and rejections set forth in the November 5, 2002 and March 25, 2003 Actions, and allowance of this application.

Respectfully submitted,

Date: November 10, 2003


Janet E. Reed, Ph.D.
Registration No. 36,252

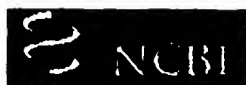
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EXHIBIT 1

(4 pages)



Nucleotide

Search for

Display Limits Show: Preview/index History Details

1: AF463528. Magnaporthe grisea...[gi:27450408]

Links

LOCUS AF463528 1047 bp DNA linear PLN 01-JAN-2003
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ACCESSION AF463528
VERSION AF463528.1 GI:27450408
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SOURCE Magnaporthe grisea
ORGANISM Magnaporthe grisea
Eukaryota; Fungi; Ascomycota; Pezizomycotina; Sordariomycetes;
Sordariomycetes incertae sedis; Magnaporthaceae; Magnaporthe.
REFERENCE 1 (bases 1 to 1047)
AUTHORS Farman, M.L. and Leong, S.A.
TITLE DNA region containing AVR1-CO39 avirulence gene
JOURNAL Unpublished
REFERENCE 2 (bases 1 to 1047)
AUTHORS Farman, M.L. and Leong, S.A.
TITLE Direct Submission
JOURNAL Submitted (27-DEC-2001) Dept. of Plant Pathology, University of
Wisconsin, 1630 Linden Drive, Madison, WI 53706, USA
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[Disclaimer](#) | [Write to the Help Desk](#)
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Aug 20 11:17:11

[NCBI](#)[Entrez](#)[BLAST 2 sequences](#)[BLAST](#)[Example](#)[Help](#)

BLAST 2 SEQUENCES

This tool produces the alignment of two given sequences using BLAST engine for local alignment. The stand-alone executable for blasting two sequences (bl2seq) can be retrieved from [NCBI ftp site](#)
Reference: Tatyana A. Tanusova, Thomas L. Madden (1999), "Blast 2 sequences - a new tool for comparing protein and nucleotide sequences", FEMS Microbiol Lett. 174:247-250

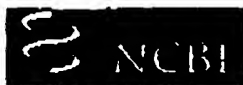
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or sequence in FASTA format from: to:

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Sequence 2 Enter accession or GI or download from file [Browse...](#)
or sequence in FASTA format from: to: [Align](#) [Clear Input](#)Comments and suggestions to blast-help@ncbi.nlm.nih.gov



Blast 2 Sequences results

PubMed

Entrez

BLAST

OMIM

Taxonomy

Structure

BLAST 2 SEQUENCES RESULTS VERSION BLASTN 2.2.6 (Apr-09-2003)

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Sequence 2 gi 27450408 Length 1047

No significant similarity was found